

REMARKS

The objection to claim 9 is attended to above as courteously suggested in the Action regardless of its merits, because non-narrowing and, therefore, without Festo-like consequences.

The rejection of claim 1 under 35 USC 112, first paragraph, is traversed on the basis of throttle 9 in discharge pipe 15 as shown in Figs. 1 and, particularly, 2, for example. Some of the medium is passed through the throttle 9 into the discharge pipe and not into the pump 3, as claimed.

Issues of Festo-like limitations are not understood to be a concern of prosecution before the Office, but the rejection of claims 8 and 14 under 35 USC 112, second paragraph, is traversed on the basis of the definition of the originally claimed "high" pressure as the now-claimed 1-300 bar at page 6, lines 14 to 18, of the original specification, as previously pointed out. The applicant may and, indeed, should take precise definitions from the specification for the claims.

The grammar and method steps of claim 1 were correct and, therefore, there could be no objection to claim 1 under 35 USC 112, second paragraph. Nevertheless, understanding is facilitated by a more usual participial formulation above without narrowing or Festo-like consequences even if considered in response to a statutory rejection.

The rejection of claim 11 under 35 USC 112, first paragraph, for double inclusion by defining apparatus instead of means as a passage is traversed by specifying the means in claim 11. Inasmuch as the scope of claim 11 is unchanged, no Festo-like consequences arise even if in response to a statutory requirement.

The rejection of claim 16 under 35 USC 112, second paragraph is well taken and traversed by restoring its original dependence from claim 11 together with antecedent consistency, neither of which raise Festo-like limitations even though in response to a statutory requirement.

The structural differences of the claims traversing the rejection under 35 USC 102 from the cited Kirkelund, et al. patent were precisely and, for that reason, also briefly set out in the Response of (January 25) 2 February 2007. Precise reconsideration is, therefore, recommended.

Such reconsideration will find the Jepson form of the claims. In a Jepson or improvement claim:

The terms in both the preamble describing the prior art and those elements constituting the improvement are substantive claim limitations. 37 CFR § 1.75(e). *Wells Mfg. Corp. v. Littlefuse, Inc.*, 192 USPQ 256 (7<sup>th</sup> Cir 1976).

Inasmuch as the substantive claim limitations of the preamble to fire extinguishing spraying method and apparatus are not found in the patent, the rejection fails. Under 35 USC 102 for anticipation:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described ...

The identical invention must be shown in as complete detail as is contained in the ... claim. *MPEP* 2131 (citations omitted).

It would be inappropriate to suggest that the claimed method and apparatus of fire extinguishing spraying are mere intended use and not method and apparatus limitations. For such limitations:

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.... (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim.) *MPEP* 2111.02 (citation omitted)

The entirety of this application shows the inventor actually invented fire extinguishing apparatus and method and not an oil burner as in the patent. Fire extinguishers are intended to put out burners, not encompass them.

If it is thought that the preamble merely recites use and not the fire extinguishing method and apparatus (structure) actually claimed, such is not the case. As the Jepson or improvement preamble of the claims comprehends many fire extinguishing methods and apparatuses, such thinking is more easily rebutted by considering whether such structure or method limitation is found in the patent. In the patent, there is no such disclosure and, in fact, opposite, burner disclosure. Therefore, every structural or method limitation of the preamble of the claims is not found in the patent.

If use is still an issue, the rule that no product patent may issue for a new, fire-extinguishing use of an old, oil-burner product as in the patent is tempered by the doctrine of slight changes. If the old product is altered, however slightly, to fit the new use, then there is no novelty bar. See, *Chisum on Patents* §1.03[8][b]. Then:

While the statute grants monopolies only for new structures, and not for new uses, invention is not to be gauged by necessary physical changes, so long as there are some, but by the directing conception which alone can beget them. *H.C. White v. Morton E. Converse & Son Co.*, 20 F2d 311 312-313 (2<sup>nd</sup> Cir. 1927).

The description bridging pages 2 and 3 of the specification also differentiate the claimed invention as previously described with a rigor not found in the Action. The Action indicates that 43 in the patent is means for re-circulating to the pump 12, but this is not so. 43 is an inlet line to a pressure regulator all on the outlet side of the pump for its discharge passing return line 41. Even the description in the Action therefore fails to anticipate the claims.

Attention is now also directed to the one way valve opposite the reference numeral 40 of the throttle in the patent. This valve passes fluid from the discharge pipe 41 to the intake side of the pump, which claim 1 does not. Therefore, the patent teaches away from claim 1.

**PRIOR ART MUST BE CONSIDERED IN ITS  
ENTIRETY, INCLUDING DISCLOSURES THAT  
TEACH AWAY FROM THE CLAIMS MPEP 2141.02 VI**  
(emphasis original).

While claim 9 does not include the negative limitation, it is doubtful that the one way valve opposite the reference numeral 40 of the throttle in the patent permits passing medium to the discharge pipe 41 when it is opened by lower intake pressure of the pump. Medium will then pass instead to the lower intake pressure. Therefore, the patent teaches away from claim 9, too.

Reconsideration and allowance are, therefore, requested..

Respectfully submitted,

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